

REMARKS

I. Claim Status

Claims 61-67 and 71-119 are currently pending. Claims 61, 62, 80, 81, 84, 86, 87, 89, 90, 92, 102, 103, 104, 108, 110, and 112 have been amended herein. Those amendments are supported in the specification and claims as originally filed. Accordingly, no new matter is added herein. Claims 61-119 stand rejected.

II. Enablement Rejection

35 U.S.C. § 112, First Paragraph Rejection of Claims 108-112 and 115

The Examiner rejected claims 102-115 under 35 U.S.C. § 112, first paragraph as allegedly lacking enablement. Office Action at 2. The Examiner acknowledged that the specification “while being enabling for treatment of the listed disease do not reasonably provide enablement for prevention.” *Id.* Applicants respectfully traverse.

As an initial matter, Applicants point out that claims 105, 106, 107, 109, 111, and 113-115 do not relate to “prevention.” Consequently, it appears that those claims were mistakenly listed as part of this rejection, and Applicants request that the rejection over these claims be withdrawn.

With respect to claims 102-104, 108, 110, and 112, without in any way conceding the propriety of the rejection and solely in an effort to expedite prosecution in this application, Applicants have amended those claims herein, rendering the rejection moot. Applicants respectfully reserve the right to pursue the deleted subject matter in a continuation application based on the present application. In view of these amendments, Applicants respectfully request that this rejection be withdrawn.

III. Indefiniteness Rejection

35 U.S.C. § 112, Second Paragraph Rejection of Claims 1-119

The Examiner rejected claims 1-119 under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. Office Action at 5. Applicants respectfully disagree.

Applicants respectfully point out that only claims 61-67 and 71-119 are currently pending. Moreover, Applicants assert that claims 64, 66, 83, 88, 89, 90, 91, 97, and the claims that depend therefrom distinctly point out and clearly claim **specific** polar head groups (PHGs). These claims leave no question as to what PHGs Applicants intend to cover.

With respect to the remaining rejected claims, solely to expedite prosecution, Applicants have amended those claims (see e.g., claim 61) to replace “derived from” with “chosen from.” Although Applicants assert that that amendment has no effect on the scope of the present claims, it clarifies that Applicants intend to cover any compound falling within the scope of the claims wherein PHG “is chosen from a phospholipid, a lysophospholipid, a monoacylglycerol, a diacylglycerol, and a triacylglycerol.” Accordingly, Applicants respectfully request that the rejection be withdrawn.

The Examiner also questioned the propriety of the claim limitation that “p is from 1 to 3,” stating “it is unclear how p can be 3 in the case of where PHG is defined as phospholipid or a lysophospholipd [sic], where, in those cases, a least 1 -OH group would be occupied by a phosphate group.” Office Action at 5.

Applicants agree that p cannot be 3 when PHG is chosen from a phospholipid or lysophospholipid. However, Applicants see no problem with the wording of the present claims. One of ordinary skill in the art would be familiar with the structure of, for example, a phospholipid or lysophospholipid and would understand that in those

situations where PHG is chosen from one of those groups, p would be 1 or 2. There is nothing in the present claims to suggest that p=3 must be available for all possible PHGs. Therefore, this rejection is improper and should be withdrawn.

The Examiner also noted that Applicants amendment to claim 61 in their July 22, 2008, Amendment and Response included a requirement “when X is S,” but X was not defined to include X. Office Action at 6. Applicants regret this inadvertent typographical error. Instead of “when X is S,” Applicants meant to amend claim 61 to read “when Y is S.” That amendment has been made herein, rendering this rejection moot.

IV. Double Patenting Rejection

The Examiner provisionally rejected claims 61-67 and 71-119 on the grounds of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1, 9, 13, 20-23, 32, 33, 39-44, and 48 of copending Application No. 10/484,855. Office Action at 9. Applicants request that the Examiner hold this rejection in abeyance until allowable subject matter is found.

V. 102(b) Rejections

Rejection over Ruoxin

The Examiner has rejected claims 61-64, 67, 84, and 86 under 35 U.S.C. § 102(b) as allegedly being anticipated by Ruoxin et al. *J. Org. Chem.* (1993) 58:1952-1954 (“Ruoxin”). Office Action at 6. Applicants respectfully traverse.

Claim 61 has been amended herein. As amended claim 61 contains the limitation “wherein Z is a C₁-C₆ alkyl group when Y is S and PHG is a phosphatidylethanolamine phospholipid or phosphatidylethanolamine lysophospholipid.” The compound of formula 11 in Ruoxin to which the Examiner points as being allegedly

anticipatory does not meet this claim limitation. In particular, the Examiner incorrectly stated that in formula 11, Z would equal a C₆ alkyl group. See Office Action at 7. Instead formula 11 includes a carbon chain between the C=O group and the S that includes 7 carbons. Therefore, because formula 11 of Ruoxin is a phosphatidylethanolamine phospholipid, Z cannot be an alkyl group with more than 6 carbons. This same analysis applies for compounds 12-14 reported in Ruoxin. Thus, Ruoxin does not anticipate the present claims, and the rejection should be withdrawn.

Rejection over Lehninger

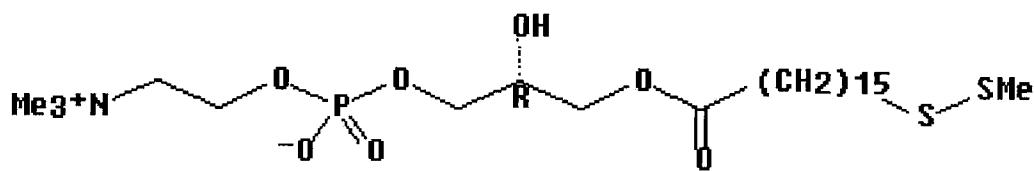
The Examiner also rejected claims 61-79, 82, 84, 86-90, 92-96, and 98-101 under 35 U.S.C. § 102(b) as allegedly anticipated by Lehninger et al., *Principles of Biochemistry*, 2nd ed., 1993, Worth Publishers, Inc., pp. 246-251 (“Lehninger”). Office Action at 7. Applicants respectfully traverse.

The compounds disclosed in Lehninger do not anticipate the present claims because they do not satisfy each and every limitation of claim 61. For example, amended claim 61 requires that “Y is chosen from S, Se, SO₂, and SO.” In other words, the fatty acid chain of the compounds falling within the scope of the present claims must include one of those sulfur-containing groups. Because the compounds of Lehninger do not contain S in their fatty acid chains, this rejection should be withdrawn.

Rejection over Runquist

The Examiner rejected claims 65, 66, 80, and 81 under 35 U.S.C. § 102(b) as allegedly anticipated by Runquist et al., *Biochimica et Biophysica Acta, Biomembranes* (1988) 940(1):10-12 (“Runquist”). Office Action at 7-8. Applicants respectfully traverse.

In support of the rejection, the Examiner points out that Runquist teaches the following compound:

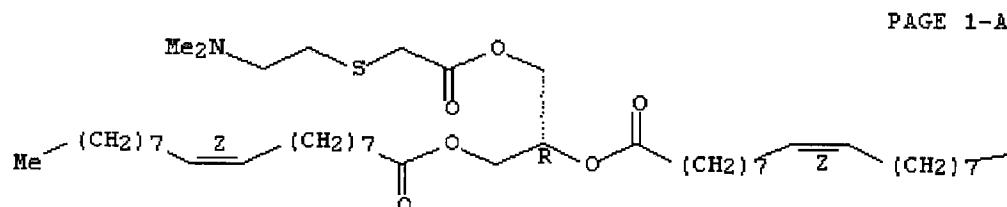


Applicants respectfully point out that the Runquist compound does not anticipate the present claims for at least the reason that Z cannot be a carbon chain having greater than 10 carbons. See claim 61. Therefore, this rejection should be withdrawn.

Rejection over WO 2000/0030444

The Examiner rejected claims 89 and 90 35 U.S.C. § 102(b) as allegedly anticipated by WO 2000/0030444 ("WO '444"). Office Action at 8. Applicants respectfully traverse.

The compound disclosed in WO '444 having the formula:



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does not anticipate the present claims for at least the reason that it fails to satisfy the claim limitation: "X², X³, and X⁴ are independently chosen from a substituted or unsubstituted C₆-C₂₄ alkyl, C₆-C₂₄ alkenyl, and C₆-C₂₄ alkynyl." In particular, the ethyl amino group of the above formula does not fall within the scope of a C₆-C₂₄ alkyl group because it has only 2 carbon atoms. Therefore, this rejection should also be withdrawn.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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